

Applicant : Don Fishbein
Serial No. : 10/799,264
Filed : March 12, 2004
Page Page 5 of 9
of Amendment

REMARKS

Claims 30-47 are pending and under examination. Applicant has hereinabove amended claim 30. Support for the amendments to claim 30 can be found in the specification as originally filed at, *inter alia*, page 22, lines 14-16.

Priority

In the December 17, 2009 Office Action the Examiner objected to the currently claimed priority and asserted that U.S. Provisional Application No. 60/032,414 does not support the invention as instantly claimed. The Examiner asserted that the filing date of the present application, i.e. March 12, 2004, is considered the priority date of the presently claimed invention.

In response, applicant respectfully traverses the Examiner's rejection. Applicants have amended the claims to recite features supported in U.S. Provisional Application No. 60/032,414. With regard to the amendment to claim 30 hereinabove, applicant directs the Examiner specifically to page 22, lines 14-16 of U.S. Provisional Application No. 60/032,414.

Accordingly, applicant maintains that the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and request that the Examiner reconsider and recognize on the record applicant's December 5, 1996 priority date.

Rejection of Claims Under 35 U.S.C. §112, New Matter

The Examiner rejected claims 30-47 as containing new matter

Applicant : Don Fishbein
Serial No. : 10/799,264
Filed : March 12, 2004
Page Page 6 of 9
of Amendment

and not complying with the written description requirement. The Examiner asserted that no support could be found for the limitation that the weight gained is maintained at five weeks after discontinuation of oxandrolone administration. The Examiner asserted that therefore that the claims are rejected because they contain new matter not supported by the specification.

In response, applicant respectfully traverses the Examiner's rejection. However, in order to expedite prosecution, and without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 30, from which the remaining claims depend, to recite "wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration". Applicant maintains that such is supported in the specification at page 22, lines 14-16. Additionally, applicant notes that during a March 12, 2010 telephone conference between Examiner Alicia Hughes and Mr. Brian Amos of the undersigned's office, Examiner Hughes indicated that the claim characteristic "wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration" was supported in the application and that such an amendment to the claim would overcome the new matter rejection. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejection of Claims 30-40 and 42-45 Under 35 U.S.C. §102(a)

Based on the Examiner recognizing only a March 12, 2004 priority date for the presently claimed invention, the Examiner rejected claims 30, 42-45 and 47 under 35 U.S.C. §102(a) as anticipated by Demling, *Burns* 29:793-797 (2003).

Applicant : Don Fishbein
Serial No. : 10/799,264
Filed : March 12, 2004
Page Page 7 of 9
of Amendment

In response, applicant respectfully traverses the Examiner's rejection. As amended herein the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art and the rejection should be withdrawn.

Rejection of Claims 30-40 and 42-45 Under 35 U.S.C. §103(a)

Based on the Examiner recognizing only a March 12, 2004 priority date for the presently claimed invention, the Examiner rejected claims 30, 42-45 and 47 under 35 U.S.C. §102(a) as obvious over anticipated by Demling, *Burns* 29:793-797 (2003) in view of Berger (U.S. Patent No. 6,090,799).

In response, applicant respectfully traverses the Examiner's rejection. As amended herein the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art.

In addition, Berger (U.S. Patent No. 6,090,799), cited by the Examiner for disclosing administration of oxandrolone, does not suggest administration of oxandrolone for the treatment of burns (as acknowledged by the Examiner on page 8 of the Office Action). Berger also does not render obvious a method wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration. Accordingly, the obviousness rejection should be withdrawn.

Applicant : Don Fishbein
Serial No. : 10/799,264
Filed : March 12, 2004
Page Page 8 of 9
of Amendment

Rejection of claims 30 and 41 Under 35 U.S.C. §103(a)

The Examiner also rejected claims 30 and 41 under 35 U.S.C. §103(a) as allegedly obvious over Demling, Burns 29:793-797 (2003) in view of Labrie et al. (U.S. Patent No. 5,434,146).

In response, applicant respectfully traverses the Examiner's rejection. As amended herein the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art.

In addition, Labrie et al. (U.S. Patent No. 5,434,146), cited by the Examiner for disclosing administration of anabolic steroids in a sustained release formulation, does not suggest administration of oxandrolone to effect weight gain after weight loss resulting from burn-induced trauma. Labrie et al. also does not render obvious a method wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration. Accordingly, the obviousness rejection should be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorneys invite the Examiner to telephone them at the number provided below.

Applicant : Don Fishbein
Serial No. : 10/799,264
Filed : March 12, 2004
Page Page 9 of 9
of Amendment

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:	
Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	
<i>Gary J. Gershik</i> John P. White Reg. No. 28,678 Gary J. Gershik Reg. No. 39,992	<i>3/16/10</i> Date

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